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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/489,420	01/21/00	MACQUEEN	0312-058-999.

020583 IM22/1023  
PENNIE AND EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2711

EXAMINER  
BERMAN, S

ART UNIT	PAPER NUMBER
1711	10

DATE MAILED: 10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/489,420

Applicant(s)

MACQUEEN ET AL.

Examiner

Susan W Berman

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-16 and 18-57 is/are pending in the application.
- 4a) Of the above claim(s) 24-45 is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-6, 8-10, 14, 16, 18, 19, 21-23, 46-48, 50 and 52-56 is/are rejected.

7) ☒ Claim(s) 11-13, 15, 20, 49, 51, 57 and 58 is/are objected to. (*Ref under D.P. obj.*)

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- ☐ If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7, 8, 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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***Election/Restrictions***

Applicant's election without traverse of Group I in Paper No. 6 is acknowledged. New claims 46-58 are grouped with claims 1-23 in invention Group I.

This application contains claims 24-45 drawn to an invention nonelected without traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Specification***

Applicant has amended the specification by capitalizing the trademarks used in the description.

***Claim Rejections - 35 USC § 112***

The amendments to claims submitted 08-24-01 overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in paper number 5. See paper number 6, pages 15-19 for a detailed discussion.

***Claim Rejections - 35 USC § 102 and/or 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-6, 8-10, 14, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by McDowell (4,169,167). McDowell discloses compositions comprising a radiation curable resin, initiator and silica, wherein the silica corresponds to the rheological control agent in the instant claims. The viscosity of the compositions is not specifically mentioned. See column 11, lines 1-41, and the examples. Compositions comprising silica disclosed by McDowell would be expected to have viscosities within the instantly claimed range in the absence of evidence to the contrary. Those compositions disclosed by McDowell having viscosities within the instantly claimed range are considered to anticipate the instantly claimed compositions.

The burden is hereby shifted to applicant to establish by effective argument and/or objective evidence that the prior art product(s) or process(es) do not necessarily possess the characteristics of the claimed products or processes. Note In re Spada, 911 F. 2d 705, 709, 15 UPQ2d 1655, 1658 (Fed. Cir. 1990), "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not". Note In re Fitzgerald, 205 USPQ 594 (CCPA 1980). The reference discloses all the limitations of the claim(s) except a property or function and the examiner cannot determine whether or not the reference inherently possesses properties or functions which anticipate the claimed invention. See MPEP 2112-2112.02.

Claims 1-6, 8-10, 14, 16, 18, 19, 21, 23, 46-48, 52, 55 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller, Jr. et al (4,348,447). See column 1, lines 30-38, column 3, line 18, to column 4, line 59 and column 6, lines 32-53. Miller, Jr. et al teach that the curable matrix should have a viscosity between 4000 and 12000 cPs.(column 6, lines 39-52). With respect to claims 1-6, although Miller, Jr. et al do not teach the instantly claimed viscosity range of the curable matrix containing a rheological control agent and/or particles. However, the added rheological control agent and/or particles would be expected to increase the viscosity to within the range set forth in instant claim 1.

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Therefore, it is the examiner's position that Miller, Jr. et al disclose compositions having viscosities within the instantly claimed range in the absence of evidence to the contrary. With respect to claims 8-10, 14, 16, 19, 46-48, 52 and 55: the particles taught by Miller, Jr. et al meet the instant claim requirements for either a rheological control agent or texture-producing particles because the claims do not recite any of the distinguishing features set forth in the specification. With respect to claims 14, 16, 52: although Miller, Jr. et al do not specifically teach the instantly claimed weight percents, compositions disclosed by Miller, Jr. et al in which the components are present in amounts within the instantly claimed ranges anticipate the instant claims.

The burden is hereby shifted to applicant to establish by effective argument and/or objective evidence that the prior art product(s) or process(es) do not necessarily possess the characteristics of the claimed products or processes. Note In re Spada, 911 F. 2d 705, 709, 15 UPQ2d 1655, 1658 (Fed. Cir. 1990), "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not". Note In re Fitzgerald, 205 USPQ 594 (CCPA 1980). The reference discloses all the limitations of the claim(s) except a property or function and the examiner cannot determine whether or not the reference inherently possesses properties or functions which anticipate the claimed invention. See MPEP 2112-2112.02.

Applicant argues, in paper number 6, that Miller, Jr. et al do not teach particles having an average diameter larger than the pre-cured coating thickness. This argument is not persuasive because the reference teaches a coating layer wherein the particles protrude from the matrix and because the references teaches particle sizes from 149-595 microns, which is within the size range for the particles set forth in claim 23. It is agreed that Miller, Jr. et al do not teach using a combination of particles agent having a particle size from 1-100 nm with particles having a particle size from 30-300 microns. However, the rejected claims do not recite these limitations.

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*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 46-48, 52-54, 56 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi (5,763,048). Takahashi discloses a matte decorative sheet comprising a ionizing radiation cured protective layer that contains fine particles of an impact-resistant resin, such as polycarbonate, nylon or polypropylene. See column 4, lines 1-17, column 5, lines 9-19, column 6, lines 23-36, and the Examples. Takahashi teaches adding particulate dispersion improvers having a particle diameter of not more than  $\frac{1}{4}$  of that of the fine particles of impact resistant resin (column 6, lines 5-12). It would have been obvious to one skilled in the art to include additives such as silica or talc, etc. having a particle diameter not more than of that of the fine particles of impact resistant resin in the compositions disclosed by Takahashi in order to improve particulate dispersion in the composition, as taught by Takahashi.

Claims 46-48, 50, 52-54 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (6,228,463). Chen et al disclose compositions for coverings containing dispersed wear-resistant particles. Particles such as polymeric particles or alumina particles having a size between 10-350 microns are taught. Suspension aids include polyamide and fumed silica or alumina having a submicron particle size, preferably from 5-25 nm. See column 4, lines 6-28, column 5, lines 28-33 and lines 42-56, column 6, lines 40-67, column 7, line 57, to column 8, line 10, column 8, lines 48-50, column 9, lines 50-64, and Examples 7 and 8.

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Chen et al do not mention including an initiator in the radiation curable resin; however, it would be expected that the commercial urethane acrylate compositions employed in the examples contained an initiator. It would have been obvious to one skilled in the art to include an initiator in a radiation curable urethane acrylate when curing the compositions with UV light as taught by Chen et al in Example 8. It is well known in the art of radiation curing that a photoinitiator is employed when using UV light to cure compositions comprising acrylate curable groups.

*Response to Amendment & Arguments*

It is noted that applicant defines "macroscopic texture" an encompassing "any textural features, regular or irregular, produced on the surface of a coating that are visible to the naked eye".

The rejection of claims as being anticipated by Slosberg et al (3,267,187) is withdrawn. Slosberg et al do not disclose a radiation curable resin and initiator having the viscosity set forth in claim 1.

The rejection of claims as being anticipated by Troue (4,421,784) is withdrawn. Troue teaches compositions having viscosities between 50 cPs and 10,000 cPs, wherein the viscosity is increased by UV curing.

The rejection of claims as being anticipated by Courtoy et al (Re 33,069) is withdrawn in response to applicant's amendments. Courtoy et al do not discuss viscosity of the compositions or teach employing particles with a rheological agent in the compositions.

The rejections of claims as being anticipated by Gorzalski et al (5,585,415) and as being unpatentable over Gorzalski et al (5,585,415) in view of Gallouedec et al in the article "Enhancement of Mechanical and Optical Properties... Using Ultra-Fine Polyamide Powders" are withdrawn. It is agreed that Gorzalski et al teach coating compositions for providing a fine, uniform surface wrinkling effect that is a microscopic effect.

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It is suggested that applicant amend the instant claims as follows. In all claims, change "mixture capable of forming a macroscopic texture" to "mixture that forms a macroscopic texture". Claim 46: change "texture-producing particles" to "texture-producing particles having an effective size or average diameter that is larger than the thickness of the pre-cured coating applied to a substrate. See page 10, lines 3-6.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6, 8-16, 18-23 and 46-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of copending Application No. 09/765713. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. The comprising language of the claims in SN '713 encompasses the compositions having the viscosities recited in the instant claims 1-6, 8-16, 18, 19 and 20. The comprising language of the claims in SN '713 encompasses the compositions comprising a combination of rheological control agent and texture-producing particles recited in claims 46-58 and 21-23. Claim 16 in SN '713 recites many of the limitations of the instant dependent claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.



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*Allowable Subject Matter*

The following is a statement of reasons for the indication of allowable subject matter:

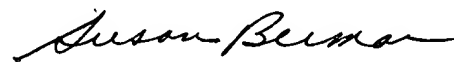
The prior art of record and otherwise known to the examiner does not teach or suggest the combination of specifically sized nylon particles, alumina particles having a particle size distribution from 27 to 56 nanometers, aluminosilicates, a prehydrolyzed silane coupling agent with the resin mixture and acylphosphine oxide photoinitiator set forth in claim 20.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Berman whose telephone number is (703) 308-0040.

The fax number for this group is (703) 872-9310 or, for submissions after Final Rejection, (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service telephone number (703) 306-5665.



Susan Berman  
Primary Examiner  
Art Unit 1711

S B  
10/9/01

001210-02469460